



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/903,583	07/13/2001	Kazuhiro Esaki	2001_1005A	9607

513 7590 03/23/2005

WENDEROTH, LIND & PONACK, L.L.P.
2033 K STREET N. W.
SUITE 800
WASHINGTON, DC 20006-1021

EXAMINER

NGUYEN BA, PAUL H

ART UNIT	PAPER NUMBER
----------	--------------

2176

DATE MAILED: 03/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/903,583

Applicant(s)

ESAKI ET AL.

Examiner

Paul Nguyen-Ba

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 29 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,5 and 7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5 and 7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 October 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Notice to Applicant

1. This action is responsive to Applicant's Amendment and Arguments filed on 10/29/2004.
2. Claims 1, 2, 4, 5, and 7 are currently pending. Claims 1, 4, and 7 are independent claims.

Priority

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 2, 4, 5, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujieda et al. ("Fujieda"), U.S. Patent No. 6,557,002, in view of UBIC – Universal Binary Identity Code ("UBIC"), *available at* <http://www.media.mit.edu/pia/Research/SWAT/ubic.html> (search criteria: date before July 14, 2000 *via* HotBot search engine *available at* www.hotbot.com), in further view of McCay et al. ("McCay"), U.S. Patent No. 6,223,137.

Independent Claim 1

Fujieda teaches a method of *managing products each having a plurality of parts* (see Abstract), the method comprising:

creating an original structural tree (see Figs. 6 and 9; col. 5, lines 22-26 → i.e. “parts structure tree”) *of a product which defines a relationship between the product and its parts* (see Abstract and col. 5, lines 27-35 → “matrix parts list” works in cooperation with the “parts structure tree” to output a relationships between products and its parts);

assigning part numbers to the product and parts, the same part number being assigned to products and parts having the same structure (see Figs. 4-6; col. 6, lines 35-65; col. 7, lines 20-31 → *compare with* “product names” and “element names”);

entering the numbers in the structural tree (see col. 5, lines 44-49 → “parts registration function” receives input information required for adding new products);

storing the resultant structural tree in a database connected to a computer (see Fig. 1 and col. 5, lines 16-21).

Fujieda does not specifically teach *assigning unique serial numbers to the product and at least major parts thereof*.

However, UBIC teaches assigning unique serial numbers to products or parts with the same structures (see Figure and paragraph 2) for the purpose of assigning a unique label or name to every object, similar to how people have names.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the teaching of Fujieda with the teachings of UBIC to include

Art Unit: 2176

assigning unique serial numbers to products or parts with the same structures for the purpose of assigning a unique label or name to every object, similar to how people have names.

Fujieda does not specifically teach *marking the serial numbers on the product and parts assigned therewith*. However, Fujieda teaches a parts structural drawing (col. 5, lines 36-44) for the purpose of allowing assembly of the products and parts.

It was commonly known to those of ordinary skill in the art to mark the serial numbers on the product and parts assigned for the purpose of assigning a unique label or name to every object, similar to how people have names, and allowing assembly of the marked products and parts. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to mark the serial numbers on the product and parts assigned for the purpose of assigning a unique label or name to every object, similar to how people have names, and allowing easy assembly of the marked products and parts.

Fujieda does not specifically teach *linking histories of the product and parts to which the serial numbers are assigned, to the serial numbers; and storing the histories together with their linking information in the database*.

However, McCay teaches a relational database, in which is stored information specific to each instrument including: manufacturer, part number, serial number, usage history, and/or maintenance history (see col. 3 lines 34-43) for the purpose of marking, tracking, and managing medical products. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the teaching of Fujieda with the teachings of McCay to

Art Unit: 2176

include linking histories of the product and parts to which the serial numbers are assigned, to the serial numbers; and storing the histories together with their linking information in the database for the purpose of marking, tracking, and managing products.

Claim 2

Fujieda further teaches a method of linking attributes to product and part numbers; and storing the attributes in the database (see col. 12, lines 20-28, 51-55), but does not specifically teach linking attributes to serial numbers and storing the serial number attributes in the database.

However, UBIC teaches assigning unique serial numbers to products or parts with the same structures, in addition to model numbers (*compare with* “part numbers”) (see Figure and paragraph 2) for the purpose of assigning a unique label or name to every object and providing attribute information about each unique object.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the teaching of Fujieda with the teachings of UBIC to substitute linking attributes to part numbers with linking attributes to serial numbers for the purpose of assigning a unique label or name to every object and providing attribute information about each unique object.

Independent Claim 4

With respect to independent claim 4, refer to the rationale relied upon to reject independent claim 1. Furthermore, Fujieda teaches retrieving and analyzing part and product number structural tree information via a database control function by using the product/part

Art Unit: 2176

numbers (see Fig. 1 and col. 5, lines 16-21) or, in view of UBIC (as discussed above), a serial number can be used as well.

Claim 5

System claim incorporates substantially similar subject matter as claim 2, and is rejected along the same rationale.

Independent Claim 7

Independent claim 7 incorporates substantially similar subject matter as independent claim 1, and is rejected along the same rationale.

Response to Arguments

6. Applicant's arguments filed on 10/29/2004 have been considered but are moot in view of the new ground(s) of rejection.

Examiner has cited a reference in support of the position that the linking of histories to a product and parts to which serial numbers are assigned is known the art. Examiner has further made of record two other references that are considered pertinent to applicant's arguments.

Finally, Examiner has made of record a printout of the search results from the HotBot search engine showing that the "UBIC" document was available prior to July 14, 2000.

Conclusion

7. The prior art made of record and not relied upon, but considered pertinent to applicant's disclosure, is cited on Form PTO-892.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Nguyen-Ba whose telephone number is (571) 272-4094. The examiner can normally be reached on 10 am - 6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2176

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PNB



SANJIV SHAH
PRIMARY EXAMINER